

REMARKS

Claims 1-4 and 6-14 are pending. Reconsideration and allowance based on the below comments are respectfully requested.

§112 First Paragraph

The Examiner rejects claims 1-4 and 6-14 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Specifically, the Office Action alleges that the recitation of “filtered air from an air filter of the thermal engine” lacks proper written description such that one of ordinary skill would recognize that applicant had possession of the invention as claimed in view of the disclosure. This rejection is respectfully traversed.

Applicant incorporates arguments addressing the above rejection from applicant’s Response filed on September 26, 2005. Applicants provide the following further arguments.

Page 25, lines 14-21 of applicant’s original disclosure states “a hybrid vehicle system has several forced air flows, such as the thermal engine input air, turbo charger input air, air for the cooling of oil or water and air for cooling of battery cells. Therefore, several flows of reasonable cool, filtered air are available. Some of this air can be entered into the electric motor enclosure and forced to cool the surface magnets of the rotor(s). Two air flow arrows illustrate this fact. They enter at the input opening 636, pass either the air gap 639 or between the surface mounted magnet 638 of the electric traction motor, past the traction motor winding head 640 and exit at 637 after having past the outer side of the electric generator/motor rotor 602. In this way, the temperature of the magnets can be kept low.”

Applicant submits that the above description provides adequate written description for what is claimed. Applicant's claim 1 recites, *inter alia*, wherein at least part of filtered air from an air filter of the thermal engine is made to pass in such a way that at least part of the electric motor will obtain cooling from the filtered air.

Claim 6 recites, *inter alia*, an inlet for receiving filtered air from an air filter of the thermal engine and channels for receiving said filtered air and making it pass in such a way that at least part of the electric motor will obtain cooling from said filtered air.

Claim 11 recites, *inter alia*, passing a flow of air to the thermal engine through an air filter to produce filtered air and providing at least part of the filtered air from the air filter to the electric motor to provide cooling thereof.

The claims recite what is disclosed at least on page 25, lines 14-21. Specifically, the claims recite filtered air from the thermal engine being provided to the electric motor. The description on page 25, lines 14-21 certainly describes this feature. From this alone, one of ordinary skill would recognize that applicants had possession of the invention as claimed in view of the disclosure. In fact, one of lesser skill would be able to ascertain this understanding.

MPEP 2163.04 states that "the Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in applicant's disclosure a description of the invention defined by the claims." Certainly the Examiner has not met this burden.

The Examiner reasons that page 25, lines 14-18 teach "that 'engine input air', 'air for cooling of cooling oil or water', or 'air for cooling of battery cells' may be used to cool the motor," And that it is not apparent that this air is filtered. The specification states on line 16,

page 25 “therefore, several flows of reasonable cool, filtered air are available.” It is clear that filtered air is being made available from the thermal engine. Line 17 of page 25 states “some of this air can be entered into the electrical motor enclosure and forced to cool the surface magnets of the rotor(s).” Thus, it is clear that filtered air is used to cool the electric motor. A description in the specification seems to be clear on these points.

Further, line 14 of page 15 states “a hybrid vehicle system has several forced air flows, such as...” Here the specification provides examples of several air flows. However, it is not limited to these particular air flows.

The Examiner further states that “there is no teaching of how part of the air is ‘diverted’ within the air filter, or ‘downstream’ of the air filter which then enters an ‘engine intake’, such as a fuel injector system or carburetor and channel to the air inlet 636 of the motor.” First, the claims do not recite the above diversion, downstream injection system, etc. The claims recite filtered air from the thermal engine is used to cool the electric motor. Second, one of ordinary skill would understand how to direct air flow into a particular inlet from any source by arranging suitable ducts, pumps, etc., when required.

Simply stated, the Examiner has not provided a preponderance of the evidence that the written description does not adequately disclosure a description of the invention defined by the claims. As discussed above, at least on page 25, lines 14-21 a description of the features of the claims is disclosed. The level of detail the Examiner seems to be requiring is not recited in the claims nor is it necessary. Therefore, the Examiner has not met his burden. The written description requirement is satisfied for the claimed features. Accordingly, withdrawal of the rejection is respectfully requested.

If the Examiner maintains the rejection with regard to the written description requirement, applicant respectfully requests the Examiner to contact the applicant's representative Chad Billings at (703) 205-8001 in order to set up an interview with the Examiner and the Examiner's Supervisor to resolve this issue.

§112, Second Paragraph

The Examiner rejects claims 1-4 and 6-14 under 35 U.S.C. §112, second paragraph as failing to set forth the subject matter which applicant regards as the invention. Specifically, the Examiner states that little patentable weight is given to the limitation of the air being filtered and coming from the engine. Applicant respectfully submits that the claims recite that filtered air comes from the thermal engine. They do not recite all the various hoses, pumps, etc used to transport the filtered air nor does this have to be recited to understand the invention.

The Examiner further states that "it is unclear how a filtered engine air is made to cool the motor." It is readily understood by one of ordinary skill in the art that air can be used to cool an engine. One of ordinary skill would understand the passing air across parts of the electric motor will draw heat from the engine. Further, the use of filtered air allows clean air to cool the engine which prevents the engine from accumulating grime and dust particles. This understanding can be gleaned from the specification.

As stated above with regard to the §112, first paragraph rejection, applicants claimed features are disclosed in the specification and would readily be understood by one of ordinary skill in the art. Thus, applicant respectfully submits that all of applicant's claimed features should be given patentable weight. Since the Examiner has neglected to examine the claims

fully given each feature for patentable weight, applicant respectfully submits that any new Office Action be non-final allowing applicant full and fair chance to respond to any rejection under proper examination of the claims.

Therefore, in view of the above, applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

Prior Art Rejections

The Office Action rejects claims 1, 6, 10 and 11 under 35 U.S.C. §102(b) as being anticipated by Buschhaus, et al. (US 5,713,425) and claims 2-4, 7-9 and 12-14 under 35 U.S.C. §103(a) as being unpatentable over Buschhaus in view of Ishida (US 5,705,865). These rejections are respectfully traversed.

Buschhaus teaches a hybrid powertrain for an automatic vehicle. Buschhaus teaches the distribution of power between the combustion engine and the electric motor generator. Buschhaus, however, does not teach or suggest using filtered air from thermal engine to cool the electric motor. The Examiner has stated that this feature of applicant's independent claims of using filtered air to cool the electric motor has not been given patentable weight. However, applicant respectfully submits that patentable weight should be given to such features as discussed above with regard to the §112, first and second paragraph rejections.

Therefore, applicant respectfully submits that Buschhaus fails to teach, *inter alia*, wherein at least part of filtered air from an air filter of the thermal engine is made to pass in such a way that at least part of the electric motor will obtain cooling from the filtered air, as recited in claim 1.

Buschhaus fails to teach, *inter alia*, an inlet for receiving filtered air from an air filter of the thermal engine and channels for receiving said filtered air and making it pass in such a way that at least part of the electric motor will obtain cooling from said filtered air, as cited in claim 6.

Buschhaus also fails to teach, *inter alia*, passing a flow of air to the thermal engine through an air filter to produce filtered air and providing at least part of the filtered air from the air filter to the electric motor to provide cooling thereof, as recited in claim 11.

In view of the applicant respectfully submits that Buschhaus fails to teach each and every feature of independent claims 1, 6 and 11. Further, Ishida fails to make up for Buschhaus deficiencies. Ishida is provided to teach the features of the dependent claims and does not provide teachings of applicant's independent claims 1, 6 and 11. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

Conclusion

For at least these reasons, it is respectfully submitted that claims 1-4 and 6-14 are distinguishable over the cited art. Favorable consideration and prompt allowance are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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